

PATENT
Customer No. 22,852
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Roland BAZIN et al.) Group Art Unit: 3771
Application No.: 09/725,048) Examiner: Annette Fredricka Dixon
Filed: November 29, 2000) Confirmation No.: 8605
For: PROCESS FOR ACQUIRING)
SCANNED IMAGE DATA)
RELATING TO AN EXTERNAL)
BODY PORTION AND/OR A)
PRODUCT APPLIED THERETO)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

VIA EFS-WEB

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

In response to the Examiner's Answer mailed October 29, 2009, and pursuant to 37 C.F.R. § 41.39(b), Appellants respectfully request that the appeal commenced by the filing of the Notice of Appeal on March 23, 2009, as supported by the Appeal Brief filed June 8, 2009, be maintained. The Examiner's Answer withdrew all of the claim rejections included in the final Office Action mailed December 23, 2008, and includes only new grounds of rejection. For at least the reasons outlined in more detail herein, Appellants respectfully request that the Board of Patent Appeals and Interferences ('the Board") reverse all of the new grounds of rejection.

I. **Status of Claims**

Claims 1-3, 21-23, 49-58, 60, and 63 have been previously canceled without prejudice or disclaimer. Claims 4-20, 24-48, 59, 61 and 62 are pending in this application, of which claims 5, 9, 10, 12-20, and 24 have been withdrawn from consideration. Thus, claims 4, 6-8, 11, 25-48, 59, 61, and 62, as set forth in the Claims Appendix included in the Appeal Brief filed June 8, 2009 ("Appeal Brief"), are pending in the present application.

Of the pending claims:

Claims 7 and 8 have been objected to as being dependent on a rejected based claim. Examiner's Answer at 2.

Claim 11 has been allowed. Id.

Claims 4, 6, 25-48, 59, 61, and 62 have been rejected based on new grounds of rejection included in the Examiner's Answer. Id. at 4.

II. **Grounds of Rejection to be Reviewed on Appeal**

All of the claim rejections included in the final Office Action of December 23, 2009, have been withdrawn. Examiner's Answer at 3. Thus, all of the following grounds of rejection are new grounds of rejection to be reviewed on appeal:

Claims 4, 6, 61, and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 5,343,536 to Groh ("Groh") in view of U.S. Patent No. 3,969,516 to Stoughton ("Stoughton"). Id. at 4.

Claims 37, 46, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh and Stoughton in view of Kvedar et al., "Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development" ("Kvedar"). Id.

Claim 59 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh, Stoughton, and Kvedar in view of U.S. Patent No. 6,296,880 to Murad ("Murad"). Id.

Claim 48 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh and Stoughton in view of U.S. Patent No. 6,801,343 to Sheng ("Sheng"). Id.

Claims 25-36 and 38-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh, Stoughton, and Kvedar in view of Sheng. Id.

III. Argument

Summary of Argument

The rejection of claims 4, 6, 61, and 62 under 35 U.S.C. §103(a) based on Groh in combination with Stoughton should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, regardless of whether Groh and Stoughton are viewed individually or as a whole, those references fail to disclose or render obvious all of the subject matter recited in independent claim 4, and the Examiner has failed to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art.

With respect to claims 61 and 62, those claims depend from independent claim 48, and the Examiner has failed to show how independent claim 48 is purportedly obvious based on Groh and Stoughton. At least because claims 61 and 62 depend from independent claim 48, the Examiner has failed to show how those dependent claims are purportedly obvious based on Groh and Stoughton.

The rejection of claims 37, 46, and 47 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton and Kvedar should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, Groh, Stoughton, and Kvedar fail to disclose or render obvious all of the subject matter recited in independent claims 37 and 46, and the Examiner has failed to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art.

With respect to claim 47, which depends from independent claim 46, Groh, Stoughton, and Kvedar fail to disclose or render obvious all of the subject matter recited in claim 47, and the Examiner has failed to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art.

The rejection of claim 59 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton, Kvedar and Murad should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, the Examiner's proposed, hypothetical modification to Groh's device is contrary to its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful.

The rejection of claim 48 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton and Sheng should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful.

The rejection of claims 25-36 and 38-45 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton, Kvedar and Sheng should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, the Examiner's proposed, hypothetical modification to Groh's device would defeat its

principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful.

A. Rejection of claims 4, 6, 61, and 62 under 35 U.S.C. § 103(a) based on Groh and Stoughton should be reversed because independent claim 4 and dependent claims 61 and 62 are not *prima facie* obvious based on those references

1. Groh and Stoughton fail to teach all of the subject matter recited in independent claim 4

The Examiner rejected claims 4, 6, 61, and 62 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton. Examiner's Answer at 5. Of the claims rejected, claim 4 is the only independent claim, and Appellants request reversal of the § 103(a) rejection of independent claim 4 because the Examiner fails to establish that independent claim 4 is *prima facie* obvious. In particular, the Examiner's hypothetical combination of the Groh and Stoughton references fails to disclose all of the subject matter recited in independent claim 4, and further, the Examiner fails to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art.

According to the M.P.E.P., in order to establish a *prima facie* case of obviousness, the record must "include[] findings of fact concerning the state of the art and the teachings of the references . . ." § 2141(II) (relying on KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and confirming the legal framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966)). Moreover, "[o]nce the findings of fact are articulated, [the

rejection statement] must provide an explanation to support an obviousness rejection under 35 U.S.C. [§] 103.” Id. If it is found that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection statement “must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” § 2141(III).

At least because the Examiner has failed to provide a legally sufficient analysis and explanation required to support a proper claim rejection under § 103(a), Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 4. For example, Appellants respectfully submit that the hypothetical combination of Groh and Stoughton fails to disclose or render obvious “[a] transfer member . . . placed in direct contact with an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4.

The Examiner concedes that Groh does not disclose “application of the transfer member in contact with a cosmetic product applied to an external body portion.” Examiner’s Answer at 6. The Examiner alleges, however, that “Stoughton teaches the use of multiple formulations wherein the formulation is applied to the skin of the patient, and later comedones are removed, in order to test the efficacy of the formulations” Id. at 6-7. Further, the Examiner alleges that “[a]s the formulation is applied to the skin, the formulation would be absorbed into the skin cells in order to treat the acne, by the use of the testing device of Groh, the resulting testing of the comedones would extract the acne formulation being tested for efficacy.” Id. at 7. Based on these allegations about what Stoughton purportedly discloses, the Examiner alleges further that “it would have been obvious . . . to apply cosmetic product (like the acne treatment composition of

S[t]oughton) upon the skin, wherein the application of this product would result in the capturing of facial characteristics (comedones) including the cosmetic product worn by the patient . . . , for the purpose of testing the . . . efficacy of the acne treatment formulation.” Id.

Contrary to the Examiner’s allegations, neither Groh nor Stoughton discloses “[a] transfer member . . . placed in direct contact with an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4. As conceded by the Examiner, Groh fails to disclose such subject matter. See id. at 6. Appellants respectfully submit that Stoughton also fails to disclose this subject matter:

Stoughton discloses a composition and method for treatment of acne. (Title.) Stoughton discloses thinly spreading amounts of the composition over the skin. (Col. 2, lines 32-37.) For the purpose of analyzing the effectiveness of the composition, Stoughton discloses removing comedones from the skin with an extractor, placing the comedones into a gelatin capsule, which is then dissolved in warm phosphate buffer and an aliquot plated on a special medium in dilutions which are cultured anaerobically for seven days. (Col. 3, lines 9-13.) Thereafter, clinical appraisals of the cultures are performed to determine the effectiveness of the composition. (Col. 3, lines 13-16.)

Contrary to the Examiner’s apparent allegation, Stoughton does not disclose that the comedones removed from skin include any of the composition itself. Rather, the comedones are removed to determine the level of acne bacteria within the comedones. Thus, there is no disclosure to support the Examiner’s apparent, implicit allegation that the comedones themselves include the composition applied to the skin. Indeed, while the Examiner asserts that “the formulation would be absorbed into the skin,” the

Examiner does not identify any disclosure in Stoughton to support the Examiner's implicit assertion about the formulation being included in the comedones. Thus, the Examiner has failed to show that even if, hypothetically speaking, the method of evaluating follicular biopsy specimens disclosed in Groh were performed after the composition disclosed in Stoughton were applied to the skin, that Groh's method would result in "[a] transfer member [being] placed in direct contact with an external body portion including a cosmetic product applied thereto," as recited in Appellant's independent claim 4.

In the "Response to Argument" section, the Examiner restates the rejection statement (Examiner's Answer at 15), but still does not point to any disclosure in the Groh or Stoughton references to support the Examiner's allegation that "the resulting testing of the comedones would extract the acne formulation being tested for efficacy" (*id.*). There is simply no disclosure in Groh or Stoughton to support this allegation.

For at least the above-outlined reasons, Appellants respectfully submit that independent claim 4 is not *prima facie* obvious based on Groh and Stoughton. Therefore, Appellants submit that the rejection is improper and should be reversed, and thus, Appellants respectfully request that the Board reverse the improper rejection of independent claim 4 under § 103(a) based on Groh and Stoughton. Further, claim 6 depends from independent claim 4. Thus, claim 6 should be patentably distinguishable from Groh and Stoughton for at least the same reasons as independent claim 4, and Appellants respectfully request that the Board reverse the § 103(a) rejection of dependent claim 6 based on Groh and Stoughton.

2. Groh and Stoughton fail to teach all of the subject matter recited in dependent claims 61 and 62

Regarding the rejection of dependent claims 61 and 62 under § 103(a) based on Groh and Stoughton, Appellants respectfully note that claims 61 and 62 depend from independent claim 48, which has not been rejected under § 103(a) based on Groh and Stoughton. Indeed, neither Groh nor Stoughton discloses or renders obvious “[an] image scanner . . . configured in the form of a scanner for scanning documents,” as recited in independent claim 48, and the Examiner acknowledges this deficiency of the Groh and Stoughton references. See Examiner’s Answer at 10. For at least this reason, Appellants respectfully submit that the rejection of claims 61 and 62 under § 103(a) based on Groh and Stoughton is improper and should be reversed. Thus, Appellants respectfully request that the Board reverse the improper rejection of claims 61 and 62 under § 103(a) based on Groh and Stoughton.

B. Rejection of claims 37, 46, and 47 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton and Kvedar should be reversed because independent claims 37 and 46 are not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole

The Examiner rejected claims 37, 46, and 47 under 35 U.S.C. § 103(a) based on Groh, Stoughton, and Kvedar. Examiner’s Answer at 7. Of those rejected claims, claims 37 and 46 are the only independent claims, and Appellants request reversal of the § 103(a) rejection of independent claims 37 and 46 because, as explained in more detail below, the Examiner has failed to establish that independent claims 37 and 46 are *prima facie* obvious based on Groh, Stoughton, and Kvedar. Further, claim 47 depends

from independent claim 46. Thus, dependent claim 47 is patentably distinguishable from Groh, Stoughton, and Kvedar for at least the same reasons as independent claim 46. In addition, Groh, Stoughton, and Kvedar fail to disclose subject matter recited in dependent claim 47.

1. **Groh, Stoughton, and Kvedar fail to disclose or render obvious all of the subject matter recited in independent claim 37, and the Examiner has failed to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art**

The Examiner concedes that Groh does not disclose the “comparing of the displayed image,” as recited in independent claim 37, but the Examiner alleges that Kvedar discloses “the comparison of images for the purpose of assessing the progress of the patient’s treatment (Page 362, Column 2, Paragraph 1.)” Examiner’s Answer at 8. Thereafter, the Examiner further alleges that “it would have been obvious . . . to compare images as taught by Kvedar to monitor the progression of the patient’s treatment and determine appropriate care methods.” Id.

Appellants respectfully submit that the rejection of independent claim 37 based on the Examiner’s hypothetical combination is improper. The Examiner has misinterpreted Kvedar. Contrary to the Examiner’s allegations, Kvedar does not disclose comparing images for the purpose of assessing a patient’s progress. Rather, the portion of Kvedar to which the Examiner refers in purported support of the allegations, discloses reviewing patient histories and images and rendering opinions thereabout. Kvedar does not expressly disclose, however, relying on the images to

assess a patient's progress, and nowhere in Kvedar is there any disclosure relating to comparing images for the purpose of assessing a patient's progress. Thus, the hypothetical combination of Groh, Stoughton, and Kvedar does not disclose all of the subject matter recited in Appellants' independent claim 37, and the Examiner has failed to explain how these differences between the combined disclosures of Groh, Stoughton, and Kvedar and independent claim 37 would purportedly have been obvious to a person having ordinary skill in the art.

In the "Response to Arguments" section, the Examiner alleges that Kvedar discloses "the use of [a] database by which the images are compared in order to assess the efficacy of treatment." Examiner's Answer at 17. As noted above, Kvedar simply does not disclose this subject matter.

For at least these reasons, Appellants respectfully submit that the Examiner has (1) misinterpreted Kvedar, (2) failed to make proper findings of fact with respect to independent claim 37 and the prior art, and (3) failed to articulate any legitimate rationale in purported support concerning why the differences between the hypothetically combined disclosures of Groh, Stoughton, and Kvedar and the subject matter recited in independent claim 37 would have been purportedly obvious to a person having ordinary skill in the art. For at least these above-outlined reasons, the Examiner has failed to establish a *prima facie* case of obviousness.

Thus, Appellants respectfully submit that independent claim 37 is patentably distinguishable from the Examiner's hypothetical combination of Groh, Stoughton, and Kvedar. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 37 under § 103(a) based on those references. Groh,

Stoughton, and Kvedar fail to disclose or render obvious all of the subject matter recited in independent claim 46, and the Examiner has failed to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art

Appellants' respectfully submit that the rejection of independent claim 46 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton and Kvedar is improper at least because none of those references discloses or renders *prima facie* obvious “[a] process of evaluating a product applied to an external body portion . . . comprising: . . . viewing [a] displayed image to analyze . . . at least one characteristic [of an external body portion, and/or at least one product applied to the body portion],” as recited in independent claim 46. Rather, Groh discloses a method of using image analysis under cross-polarized light to evaluate follicular biopsy slides, Stoughton discloses a composition and method for treatment of acne, and Kvedar discloses sending, from a primary care provider to a dermatologist via the Internet, images of a patient's skin taken by a digital camera. Thus, none of those references discloses the above-noted subject matter recited in independent claim 46. Further, Appellant respectfully notes that the Examiner fails to provide any legitimate rationale in the rejection statement relating to independent claim 46 regarding how this subject matter is purportedly rendered *prima facie* obvious based on Groh, Stoughton, and Kvedar. See Examiner's Answer at 7-8. Similarly, the “Response to Arguments” section also fails to provide any such rationale. See id. at 16-17.

Thus, Appellants respectfully submit that the Examiner has (1) misinterpreted Groh, Stoughton, and Kvedar, (2) failed to make proper findings of fact with respect to independent claim 46 and the prior art, and (3) failed to articulate any legitimate rationale in purported support concerning why the differences between the Examiner's hypothetically combined disclosures of Groh, Stoughton, and Kvedar and the subject matter recited in independent claim 46 would have purportedly been obvious to a person having ordinary skill in the art. For at least these above-outlined reasons, the Examiner has failed to establish a *prima facie* case of obviousness.

Thus, Appellants respectfully submit that independent claim 46 is patentably distinguishable from the Examiner's hypothetical combination of Groh, Stoughton, and Kvedar. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 46 under § 103(a) based on those references. Further, claim 47 depends from independent claim 46. Therefore, claim 47 is patentably distinguishable from Groh, Stoughton, and Kvedar for at least the same reasons as independent claim 46, and Appellants respectfully request reversal of the § 103(a) rejection of claim 47 based on Groh, Stoughton, and Kvedar.

2. **Groh, Stoughton, and Kvedar fail to disclose or render obvious all of the subject matter recited in dependent claim 47, and the Examiner has failed to articulate any legitimate rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art**

In addition to being patentably distinguishable from Groh, Stoughton, and Kvedar for the reasons outlined in the previous section, claim 47 recites additional subject matter that further distinguishes it from those references.

Dependent claim 47 recites, “wherein the transfer member is placed in contact with an external body portion including a cosmetic product applied thereto” For at least the reasons outlined herein with respect to the § 103(a) rejection of independent claim 4 based on Groh and Stoughton, those references fail to disclose or render *prima facie* obvious at least this subject matter recited in claim 47. Further, Kvedar fails to overcome the deficiencies of that claim rejection. Thus, for this additional reason, claim 47 is patentably distinguishable from Groh, Stoughton, and Kvedar, and Appellants respectfully request reversal of the § 103(a) rejection of claim 47 based on Groh, Stoughton, and Kvedar.

C. Rejection of claim 59 under 35 U.S.C. § 103(a) based on Groh, Stoughton, Kvedar, and Murad should be reversed because independent claim 59 is not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole

- 1. Independent claim 59 is not *prima facie* obvious because the Examiner’s proposed, hypothetical modification to Groh’s device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful**

Appellants’ independent claim 59 was rejected under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton, Kvedar and Murad. Examiner’s Answer at 9. The Examiner concedes that Groh fails to disclose “analysis equipment” recited in independent claim 59. Id. The Examiner alleges, however, that “it would have been obvious . . . to modify the system of Groh/Kvedar to include the use of a corneometer as

taught by Murad, as a method of detecting the health of the skin in relationship to treatment methods.” *Id.*

Appellants respectfully submit that this claim rejection is contrary to the guidance of the M.P.E.P. and should be reversed. The M.P.E.P. cautions that in order to avoid impermissible hindsight reasoning, factual determinations related to an obviousness analysis must be made with respect to “the time the invention was made.” § 2141.01(III). Moreover, the M.P.E.P. cautions that when “determining the differences between the prior art and the claims, the question [of obviousness] is not whether the differences themselves would have been obvious, but [rather, it is] whether the claimed invention as a whole would have been obvious.” § 2141.02(I). Indeed, when considering the prior art, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” § 2143.03(VI) (second emphasis added).

Following the guidance of the above-outlined framework, the M.P.E.P. cautions that in order to establish a *prima facie* case of obviousness, “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” § 2142. Further, “the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person,” but “[k]nowledge of applicant’s disclosure must be put aside in reaching this determination” because “impermissible hindsight must be avoided and a legal conclusion must be reached on the basis of the facts gleaned from the prior art”; not on the basis of applicant’s disclosure. *Id.*

Based on this guidance, the M.P.E.P. advises that “[i]f a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” § 2143.01(VI). In other words, if the prior art teaches away from a proposed modification, then the prior art does not render a claim *prima facie* obvious. Further, if there is no reasonable expectation of the success of the proposed modification, then the prior art does not render a claim *prima facie* obvious. § 2143.02(I) (citations omitted).

Turning to the § 103(a) claim rejection based on Groh, Stoughton, Kvedar, and Murad, Appellants respectfully submit that this claim rejection is improper and should be reversed. Murad discloses the use of a corneometer for measuring skin hydration. (Col. 28, ll. 53-57.) In contrast, Groh is directed to determining the number of comedones present in a follicular biopsy slide. There is no reason an artisan in Groh's field would have looked to Murad to use a corneometer to measure skin hydration at least because it is not used for measuring the number of comedones present in a follicular biopsy slide. Thus, using a corneometer to measure the number of comedones would defeat the principle of operation of Groh's device, which relies on the use of adhesive and slides rather than a corneometer. Further, because a corneometer is not used for measuring the number of comedones present in a follicular biopsy slide, an artisan in Groh's field would have no reasonable expectation that adding a corneometer to Groh's device would be successful in improving Groh's device for measuring the number of comedones.

In the “Response to Arguments” section, the Examiner alleges that “the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” Examiner’s Answer at 17-18 (citation omitted). The Examiner thereafter alleges that “Murad teaches the use of a corneometer is to measure the health of the skin wherein the health of the skin would provide an analysis to the efficacy of the treatment of the patient’s condition.” Id.

Appellant respectfully submits that for at least the reasons outlined above, using a corneometer to measure the number of comedones would defeat the principle of operation of Groh’s device, and an artisan in Groh’s field would have no reasonable expectation that adding a corneometer to Groh’s device would be successful in improving Groh’s device for measuring the number of comedones. Thus, regardless of the Examiner’s allegations about using a corneometer to measure the health of a person’s skin, it would not have been *prima facie* obvious to modify the teachings of Groh to include a corneometer. Simply stated, Groh teaches counting comedones, and Murad does not disclose any counting of comedones or use of a corneometer to count comedones.

For at least these reasons, Appellants respectfully submit that independent claim 59 is not *prima facie* obvious based on Groh, Stoughton, Kvedar, and Murad, regardless of whether those references are viewed individually or as a whole. Therefore, Appellants respectfully request that the Board reverse the improper § 103(a) rejection of independent claim 59 based Groh, Stoughton, Kvedar, and Murad.

D. **Rejection of claim 48 under 35 U.S.C. § 103(a) based on Groh, Stoughton, and Sheng should be reversed because independent claim 48 is not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole**

1. **Independent claim 48 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful**

Appellants respectfully request reversal of the § 103(a) rejection of independent claim 48 based on Groh, Stoughton, and Sheng because those references fail to render independent claim 48 *prima facie* obvious. Claim 48 recites, *inter alia*, that a transfer image is scanned by an image scanner “configured in the form of a scanner for scanning documents.” The Examiner concedes that Groh “does not expressly disclose the use of a document scanner to scan the image from the transfer member.”

Examiner's Answer at 10. The Examiner alleges, however, that based on Sheng's disclosure of a flat bed image scanner for scanning documents, pictures, and books, “it would have been obvious . . . to utilize a flat bed image scanner . . . to enable the transfer of an image to a computer.” Id.

Appellants respectfully submit that the § 103(a) rejection of independent claim 48 based on the rejection statement's hypothetical combination of Groh, Stoughton, and Sheng is improper for a number of reasons and should thus be reversed. First, the Examiner's hypothetical modification to Groh's disclosed method of using image analysis under cross-polarized light to evaluate follicular biopsy slides would defeat its disclosed principle of operation. Groh discloses that using cross-polarized light to view

skin samples “is highly desirable because when the planes of polarization are adjusted properly, . . . the comedones will appear as glowing areas against the backdrop of a darker skin surface.” (Col. 2, ll. 54-64.) Groh thereafter discloses that programmable image analysis hardware and software is used to capture the image and store it as determined by a machine-readable task list written by the evaluating scientist. (Col. 4, ll. 47-54.) Thus, substituting the disclosed programmable image analysis hardware and software desired by Groh with the flat bed image scanner disclosed by Sheng would defeat Groh’s principle of operation of capturing an image and storing it according to a machine-readable task list for the image analysis hardware and software, since Sheng does not disclose such a capability.

Second, Sheng discloses a flat bed image scanner for scanning documents, books, and pictures (col. 1, ll. 11-13), but does not disclose any scanning of a follicular biopsy slide, such as the slide disclosed in Groh. One of ordinary skill in the art would not have had any reason to use a scanner for documents, books, and pictures in the scanning of a follicular biopsy slide. In addition, a person skilled in the art would not have any reasonable expectation that such a use for a scanner for documents, books, and pictures would be successful. Thus, the Examiner has relied on improper hindsight reasoning and Applicants’ disclosure in an effort to show that the subject matter recited in independent claim 48 would have been obvious. For at least these additional reasons, it would not have been obvious for a skilled artisan in Groh’s field to substitute Groh’s follicular-biopsy-slide scanner with Sheng’s flat bed image scanner for documents, books, and pictures.

In the “Response to Arguments” section, the Examiner states that “there is no evidence to the contrary presented by Appellant that would prevent or preclude the ability of one or another scanner device to be used.” Examiner’s Answer at 16. Appellant respectfully notes that the burden of showing *prima facie* obviousness is on the Examiner, and until *prima facie* obviousness is established, there is no burden on Appellants to provide any evidence to rebut a *prima facie* case of obviousness. For at least the reasons outlined above, the Examiner has failed to establish that independent claim 48 is *prima facie* obvious, and thus, Appellants’ purported failure to provide evidence is immaterial.

For at least the above-outlined reasons, Appellants’ independent claim 48 is patentably distinguishable from Groh, Stoughton, and Sheng, regardless of whether those references are viewed individually or as a whole. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 48 under § 103(a) based on the Examiner’s hypothetical combination of those references.

Further, claims 61 and 62 depend from independent claim 48. Thus, although claims 61 and 62 were not rejected under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton and Sheng, claims 61 and 62 are patentably distinguishable from those references for at least the same reasons as independent claim 48.

E. Rejection of claims 25-36 and 38-45 under 35 U.S.C. § 103(a) based on Groh, Stoughton, Kvedar, and Sheng should be reversed because independent claims 25 and 38 are not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole

The Examiner rejected claims 25-36 and 38-45 under 35 U.S.C. § 103(a) based on Groh, Kvedar, and Sheng. Examiner's Answer at 10. Of those rejected claims, claims 25 and 38 are the only independent claims, and Appellants request reversal of the § 103(a) rejection of independent claims 25 and 38 because, as explained in more detail below, the Examiner has failed to establish that independent claims 25 and 38 are *prima facie* obvious based on Groh, Stoughton, Kvedar, and Sheng.

1. **Independent claim 25 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful**

Appellants' independent claim 25 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton, Kvedar and Sheng. Examiner's Answer at 10. Claim 25 recites, *inter alia*, that a transfer image is scanned by an image scanner "configured in the form of a scanner for scanning documents." Although the Examiner concedes that Groh "does not expressly disclose the use of a document scanner to scan the image from the transfer member," the Examiner alleges that "Sheng discloses the use of a flat bed image scanner to scan a document or picture (13) to a digitized format for conveying the image to a computer." Examiner's Answer at 14. Thereafter, the Examiner alleges that "[i]t would have been obvious . . . to have provided the process for acquiring scanned image data, as disclosed by Groh, wherein

the image data is transferred to a second location and analyzed with the process taught by Kvedar et al., to allow remote and repeatable analysis of a condition of the external portion and the flat bed document scanner as taught by Sheng to enable the transfer of the image to a digitized computer format 12.” Id.

For at least the reasons outlined above with respect the § 103(a) rejection of independent claim 48 based on Groh, Stoughton, and Sheng, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 25. Contrary to the Examiner’s obviousness allegation, substituting the disclosed programmable image analysis hardware and software desired by Groh with the flat bed image scanner disclosed by Sheng would defeat Groh’s principle of operation by preventing a scientist from writing a machine-readable task list for the image analysis hardware and software, since Sheng does not disclose such a capability. Moreover, Sheng discloses a flat bed image scanner for scanning documents, books, and pictures (col. 1, ll. 11-13), but does not disclose any scanning of a follicular biopsy slide, as disclosed in Groh. One of ordinary skill in Groh’s art relating to analyzing follicular biopsy slides would not have had any reason to use a scanner for documents, books, and pictures in the scanning of a follicular biopsy slide. In addition, a person skilled in the art would not have any reasonable expectation that such a use for a scanner for documents, books, and pictures would be successful. Thus, the Examiner has relied on improper hindsight reasoning and Applicants’ disclosure in an effort to show that the subject matter recited in independent claim 25 would have been obvious. For at least these additional reasons, it would not have been obvious for a skilled artisan in Groh’s

field to substitute Groh's follicular-biopsy-slide scanner with Sheng's flat bed image scanner for documents, books, and pictures.

For at least the above-outlined reasons, Appellants' independent claim 25 is patentably distinguishable from Groh, Stoughton, Kvedar, and Sheng. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 25 under § 103(a) based on the rejection statement's hypothetical combination of those references. Further, claims 26-36 depend from independent claim 25. Therefore, they are patentably distinguishable from Groh, Stoughton, Kvedar, and Sheng for at least the same reasons as independent claim 25, and Appellants respectfully request reversal of the § 103(a) rejection of dependent claims 26-36 based on those references.

2. Independent claim 38 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful

Regarding the rejection of Appellants' independent claim 38 under 35 U.S.C. § 103(a) based on Groh in combination with Stoughton, Kvedar and Sheng, independent claim 38 recites "wherein the image scanner is configured in the form of a scanner for scanning documents." For at least reasons similar to those outlined above with respect to the rejection of independent claim 25 based on Groh, Stoughton, Kvedar, and Sheng, Appellants respectfully submit that independent claim 38 is not *prima facie* obvious based on those references, regardless of whether those references are viewed individually as a whole. Therefore, Appellants respectfully request that the

Board reverse the improper § 103(a) rejection of independent claim 38 based on Groh, Stoughton, Kvedar, and Sheng. Further, claims 39-45 depend from independent claim 38. Therefore, they are patentably distinguishable from those references for at least the same reasons as independent claim 38, and Appellants respectfully request reversal of the § 103(a) rejection of dependent claims 39-45 based on Groh, Stoughton, Kvedar, and Sheng.

IV. Conclusion

For at least the reasons given above, pending claims 4, 6, 25-48, 59, 61, and 62 are patentably distinguishable from Groh, Stoughton, Kvedar, Sheng, and Murad, regardless of whether those references are viewed individually or as a whole. Appellants therefore respectfully request that the Board reverse all of the claim rejections under 35 U.S.C. § 103(a), so that all of pending claims 4-20, 24-48, 59, 61, and 62 may be allowed.

To the extent that any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account 06-0916.

Reply Brief
U.S. Application No.: 09/725,048
Appellants: Roland BAZIN et al.
Attorney Docket No.: 05725.0800-00

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Christopher T. Kent
Reg. No. 48,216